



31 JAN 2007

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In re Application of
NABESHIMA et al.
Application No.: 10/598,933
Filing Date: 14 September 2006
Attorney's Docket No.: PA214WP002
For: SEMICONDUCTOR WAFER
INSPECTION DEVICE AND METHOD

DECISION

This application is before the Office of PCT Legal Administration, United States Patent and Trademark Office (USPTO) for consideration of applicant's Petition to Convert filed on 21 November 2006.

BACKGROUND

On 13 April 2005 applicant filed international application PCT/JP05/07120, which claimed priority of an earlier application filed 13 April 2004. The thirty month period for entry into the U.S. national stage expired at midnight on 13 October 2006.

On 14 September 2006, applicant filed a Transmittal Letter requesting filing under 35 U.S.C. 111 and 37 CFR 1.53 with the \$300 basic filing fee, claims and drawings but without a specification. The filing was treated as a submission under 35 U.S.C. 111(a).

On 21 November 2006, applicant filed the instant response, requesting that the 14 September 2006 filing be treated as a filing under 35 U.S.C. 371.

DISCUSSION

Applicant's use of "Utility Patent Application Transmittal" (Only for new nonprovisional applications under 37 CFR 1.53(b)) (Form PTO/SB/05 filed 14 September 2006 is inconsistent with and contradicts any desire expressed in any papers filed to enter the national stage of the PCT under 35 U.S.C. 371. A national application which requests treatment under 35 U.S.C. 111 and 37 CFR 1.53 cannot be considered the national stage application of international application PCT/JP05/027120 and is an indication of papers filed under 35 U.S.C. 111(a). In view of the above, it is proper to treat the initial filing as a filing under 35 U.S.C. 111(a). See MPEP 1893.03(a).

The application is deemed to have been filed under 35 U.S.C. 111(a) and international application PCT/JP05/07120 is abandoned with respect to the United States.

Applicant is advised that in order to claim benefit under 35 U.S.C. 120 and 365(c) of the

filing date of the international application for the common subject matter, this application (Serial No. 10/598,933) and the international application (PCT/US04/28705) designating the United States must be copending on 13 October 2006.

Applicant may wish to file a petition under 37 CFR 1.137 to revive the international application. Applicant may also consider filing a petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121 or 365(c) for the benefit of a prior-filed application. *See* 37 CFR 1.78(a)(3) and a certified copy of the priority document. In order to obtain benefit of the earlier international application, applicant must make reference to the previous application and state the relationship. The required reference may either be in an application data sheet or the specification must contain or be amended to contain such reference in the first sentence. An appropriate passage would be, "This is an continuation of international application PCT/JP05/07120, filed 13 April 2005, which designated the United States and is now abandoned."

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the priority document. The certified copy of priority document submitted to the International Bureau cannot be relied upon to perfect the claim for priority. *See* MPEP §1896.

CONCLUSION

For the reasons stated above, applicant's Petition to Convert is **DISMISSED**.

Application no. 10/598,933 is an application filed under 35 U.S.C. 111(a).

This application will be forwarded to Office of Initial Patent Examination (OIPE) for further processing.



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